

DETAILED ACTION

Applicant's amendment in the reply filed on 9/9/08 is acknowledged. Any rejection that is not reiterated is hereby withdrawn. Claims 1-48 are pending. Claims 1-37, and 44-48 are withdrawn as they are directed toward a non-elected invention groups. **Claims 38-43 are examined on the merits.**

Claim Rejections –35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 39, 40, and 43 remain rejected under 35 USC § 102 (b) as being anticipated by Zampino et al (US 5,177,057).

This rejection is maintained for reasons of record set forth in the Office Action mailed out on 4/10/2008, repeated below, slightly altered to take into consideration Applicant's amendment filed on 9/9/08. Applicants' arguments filed have been fully considered but they are not deemed to be persuasive.

Zampino et al teach a mixture for perfumed articles including detergent (thus suitable for applying to surfaces that come into contact with barnacles), fabric softener compositions, hair preparations. The mixture comprises 2.5% trans-beta-ocimene, 9.64% geraniol (effector agent), 17.8% unreacted linolool, and 34.37% alpha-terpineol (paint base). Zampino et al also teach the product can be used in lacquers (col 13, lines 50-55) (see Abstract; Table 1).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble ‘breathes life’ into the claims in that the prior art product must not be precluded for use as an anti-barnacle, and paint composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

Applicant argues that “Zampino does not teach using the recited compounds in a paint base. Detergent, fabric softener, foodstuffs, chewing gum, and the hair preparations as taught do not comprise a paint base. Therefore, Zampino does not anticipate claim 3 8 or any of its dependents” (page 11, 2nd paragraph from the bottom).

This is not found persuasive. As indicated above, the composition contains 34.37% alpha-terpineol, which could serve as a paint base. Therefore, the reference is deemed to anticipate the instant claim above.

Claims 38, 39, 40, and 43 remain rejected under 35 USC § 102 (b) as being anticipated by Hood (US 6,103,241).

This rejection is maintained for reasons of record set forth in the Office Action mailed out on 4/10/2008, repeated below, slightly altered to take into consideration Applicant's amendment filed on 9/9/08. Applicants' arguments filed have been fully considered but they are not deemed to be persuasive.

Hood teaches the essential oil for treatment of ailments of human body, and is applied topically to relieve pain, minimize bruising and to assist in healing, and may be used either pure or in a carrier (col 1, lines 17-22), the composition comprises 0.65% trans-beta-ocimene, 1.24% limonene (an effector agent), and 2.25% alpha-terpineol (thus a paint base) (example 1).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as an anti-barnacle, and a paint composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

Applicant argues that "Hood is cited as teaching an essential oil for treating ailments of human body, such as pain, bruising, wound healing. It may be used in a carrier. Hood does not, however, teach or suggest using the essential oil in a paint base, as required by amended

independent claim 3 8. Thus Hood does not anticipate claim 3 8 or its dependents" (page 12, 2nd paragraph).

This is not found persuasive. As indicated above, the composition contains 2.25% alpha-terpineol, which could serve as a paint base. Therefore, the reference is deemed to anticipate the instant claim above.

Claims 38, 39, and 43 are newly rejected under 35 USC § 102 (b) as being anticipated by AGENCY OF IND SCI & TECHNOLOGY (JP 73010054 B).

This is a new rejection necessitated by the Applicant's amendment filed on 9/9/08.

AGENCY OF IND SCI & TECHNOLOGY teaches a Japanese lacquer-like paint comprises allowing a residual (I) obtained by extracting catechol from an acid oil of a low temperature coal tar to react with an aliphatic hydrocarbon (II) having >2 unsaturated linkages by heating in the presence of a Friedel-Crafts catalyst. The raw material (I) is a mixture of catechol derivatives consisting mainly of monoalkyl catechol (thus a paint base) and dialkyl catechol (thus an effector agent). Suitable aliphatic hydrocarbons (II) are myrcene, ocimene (thus either cis or trans), or other natural unsaturated terpenes, or a synthetic substance such as butadiene-oligomer obtained by oligomerising butadiene with an ethyl lithium-ferric chloride-triphenyl phosphine type catalyst. Reaction can be carried out in an autoclave at 120-250 degrees C. A red-brown transparent oily material is obtained which gives an excellent paint film (see Abstract, the rejection is based on the abstract, and full translation of the document has been ordered).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble ‘breathes life’ into the claims in that the prior art product must not be precluded for use as an anti-barnacle composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-43 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Zampino et al. (US 5,177,057).

This rejection is maintained for reasons of record set forth in the Office Action mailed out on 4/10/2008, repeated below, slightly altered to take into consideration Applicant’s amendment filed on 9/9/08. Applicants’ arguments filed have been fully considered but they are not deemed to be persuasive.

Zampino et al teach a mixture for perfumed articles including detergent (thus suitable for applying to surfaces that come into contact with barnacles), fabric softener compositions, hair preparations. The mixture comprises 2.5% trans-beta-ocimene, 9.64% geraniol (effector agent),

17.8% unreacted linolool, and 34.37% alpha-terpineoletc (paint base). Zampino et al also teach the product can be used in lacquers (col 13, lines 50-55) (see Abstract; Table 1).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble ‘breathes life’ into the claims in that the prior art product must not be precluded for use as an anti-barnacle, and paint composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Zampino et al do not teach a composition comprising 3-25 or 6-25% compound.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the invention of Zampino et al since Zampino et al teach the mixture augments or enhances the aroma of perfume composition to produce a pleasant and desired fragrance (col 12, lines 60-69). Since the mixture yielded beneficial results in perfumed articles, one of ordinary skill in the art would have been motivated to make the modifications. Zampino et al also teach that in the perfume compositions, it is the individual components contribute to its particular olfactory characteristics (col 13, lines 10-15), and slight variation in the time of reaction will cause the percentages of the ingredients of the mixture to vary (col 12, lines 35-40), thus regarding the limitation to the amount of the component in the composition, the result-effective adjustment in conventional working parameters is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan, which is dependent upon the individual taste of the consumer.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Applicant argues that “As discussed above, Zampino teaches compositions for use in perfumed articles, including detergent, fabric softener, and hair preparations, such as hair spray and conditioning shampoos. Nowhere does Zampino suggest combining the active agents with a paint base as required by the claims as amended. The uses taught by Zampino (as a fragrance) would not have suggested the use in a paint base nor as an anti-barnacle composition” (page 12, 6th paragraph).

This is not found persuasive. As indicated above, the composition contains 34.37% alpha-terpineol, which could serve as a paint base. The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble ‘breathes life’ into the claims in that the prior art product must not be precluded for use as an anti-barnacle, and paint composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims. Therefore, the invention as a whole is *prima facie* obvious over the references.

Claims 38-43 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hood (US 6,103,241).

This rejection is maintained for reasons of record set forth in the Office Action mailed out on 4/10/2008, repeated below, slightly altered to take into consideration Applicant's amendment filed on 9/9/08. Applicants' arguments filed have been fully considered but they are not deemed to be persuasive.

Hood teaches the essential oil for treatment of ailments of human body, and is applied topically to relieve pain, minimize bruising and to assist in healing, and may be used either pure or in a carrier (col 1, lines 17-22), the composition comprises 0.65% trans-beta-ocimene, 1.24% limonene (an effector agent), and 2.25% alpha-terpineol (thus a paint base) (example 1).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as an anti-barnacle, and a paint composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the composition of Hood since Hood teaches the essential oils containing trans-beta-ocimene reduces pain and aids in the healing of skin. Since the compositions yielded beneficial results in pharmaceutical industry, one of ordinary skill in the art would have been motivated to make the modifications. Regarding the limitation to the amount of the component in the composition, the result-effective adjustment in conventional working parameters is deemed merely a matter of judicious selection and routine optimization which is

well within the purview of the skilled artisan, which is dependent on the plant species wherein essential oil derived from, and the distillation process from which the oil is produced.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Applicant argues that "As discussed above, Hood taught uses of treating the human body for pain, bruising, and wound healing. Nowhere did he suggest use in a paint base or for anti-barnacle treatment of surfaces. It is respectfully submitted that the subject matter of the amended claims is not obvious over the teachings of Hood" (page 12, last paragraph bridging page 13).

This is not found persuasive. As indicated above, the composition contains 2.25% alpha-terpineol, which could serve as a paint base. The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as an anti-barnacle, and paint composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims. Therefore, the invention as a whole is *prima facie* obvious over the references.

Claims 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over AGENCY OF IND SCI & TECHNOLOGY (JP 73010054 B).

This is a new rejection necessitated by the Applicant's amendment filed on 9/9/08.

AGENCY OF IND SCI & TECHNOLOGY teaches a Japanese lacquer-like paint comprises allowing a residual (I) obtained by extracting catechol from an acid oil of a low temperature coal tar to react with an aliphatic hydrocarbon (II) having >2 unsaturated linkages by heating in the presence of a Friedel-Crafts catalyst. The raw material (I) is a mixture of catechol derivatives consisting mainly of monoalkyl catechol (thus a paint base) and dialkyl catechol (thus an effector agent). Suitable aliphatic hydrocarbons (II) are myrcene, ocimene (thus either cis or trans), or other natural unsaturated terpenes, or a synthetic substance such as butadiene-oligomer obtained by oligomerising butadiene with an ethyl lithium-ferric chloride-triphenyl phosphine type catalyst. Reaction can be carried out in an autoclave at 120-250 degrees C. A red-brown transparent oily material is obtained which gives an excellent paint film (see Abstract, the rejection is based on the abstract, and full translation of the document has been ordered).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as an anti-barnacle composition. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

AGENCY OF IND SCI & TECHNOLOGY does not teach a composition comprising 0.1-50%, 3-25% or 6-25% compound.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the invention of AGENCY OF IND SCI & TECHNOLOGY since

AGENCY OF IND SCI & TECHNOLOGY teaches that a red-brown transparent oily material is obtained which gives an excellent paint film. Since the mixture yielded beneficial results in paint. Regarding the limitation to the amount of the component in the composition, the result-effective adjustment in conventional working parameters is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Applicant's arguments have been fully considered but they are not persuasive, and therefore the rejections in the record are maintained.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QM

/Michele Flood/

Primary Examiner, Art Unit 1655